

REMARKS

Claim Objections

In the 24 December 2003 office action, the Examiner objected to the form of claims 23 and 70 which the Applicant has noted. The objections are moot given the changes in claims detailed above.

35 U.S.C. § 101 Rejection of Claim

In the 24 December 2003 office action, claims 1 and 3 - 22 are rejected under 35 U.S.C. § 101 because they are directed to non-statutory subject matter. The Applicant respectfully disagrees with this assessment and traverses these rejections by noting that the rejected claims describe the use of concrete, tangible measures to support the development of useful information – the very definition of statutory subject matter.

35 U.S.C. § 103 Rejection of Claim

In the 24 December 2003 office action, claims 1 - 91 are rejected under 35 U.S.C. § 103 (a) as being unpatentable over Ching (U.S. 6,078,901) in view of Donner (U.S. 6,263,314). This Examiner supplements this theoretical combination with unsupported opinions about well known industry knowledge regarding data types, intangibles, risks, value impact and other aspects of the invention. A *prima facie* case for obviousness requires, among other things, a combination or modification of references that would make the invention obvious and a suggestion to combine or modify the references. More specifically, MPEP § 2143.01 provides:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.

The Applicant traverses all § 103 rejections by noting that the Examiner has not provided references for several aspects of the claimed invention and that the Examiner has also failed provided any evidence indicating that there was a suggestion in the prior art that the theoretical combination of Ching and Donner would be desirable. This omission is critical because the specification of Ching makes it clear that it would not be desirable to combine Ching with Donner. More specifically, Ching teaches away from a combination with Donner by stating that the method used by Donner is defective (please

see sections 13 through 18). Anyone who relied on Ching could not reasonably be expected to combine it with a reference such as Donner that Ching has identified as being defective. MPEP § 2145 X.D.2 provides that:

It is improper to combine references where the references teach away from their combination.

35 U.S.C. § 112 Rejection of Claim

In the 24 December 2003 office actions claims 1 – 91 are rejected because they are subject to undue breadth of claims. More specifically, the Examiner states that the subject claims “cover every conceivable way of using data from every conceivable systems”. The Applicant respectfully disagrees and notes that the rejected claims allow one skilled in the art to determine with a reasonable degree of certainty the scope of the invention for which protection is sought. Furthermore, the fundamental principle of 35 U.S.C. § 112 second paragraph provides that applicants are free to define in the claims what they regard as their invention in whatever terms they chose so long as the terms are not used in ways that are contrary to the accepted meanings in the art.

Under this same heading the Examiner also asks for better definitions for words defined in the specification and other terms. Definitions are provided below to facilitate prosecution.

Optimal mix – Shortened version of the “optimal mix of risk reduction products and risk reduction activities” described on page 84 (see excerpt below, further definition in revised of specification and claims).

The software in the block determines the optimal mix of risk reduction products (derivative purchase, insurance purchase, etc.) and risk reduction activities (reducing credit limits for certain customers, shifting production from high risk to lower risk countries, etc.) for the company under each scenario given the confidence interval established by the user (20) in the system settings using a linear programming optimization algorithm.

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Brand – A symbol or device indicating ownership or source : mark, hallmark, label, logo, logotype, trade mark, stamp, tag, seal. ¹ A distinctive style usually associated with manufactured goods : model, cut, line, make, pattern. ²

¹Excerpted from *American Heritage Talking Dictionary*. Copyright © 1997 The Learning Company, Inc. All Rights Reserved.

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P2* > Process - A series of actions, changes, and/or functions bringing about a result.³

Distribution channel – A way of selling a company's products. Synonym: channel.⁴

The Examiner will note that value impact is defined in the amended specification and that relationship is not used independently in the new claims. As a result, the Applicant believes that the request for a definition of relationship is moot.

Reservation of Rights

The Applicant hereby explicitly reserves the right to present the cancelled claims for re-examination in their original format. The cancellation of the pending claims to expedite allowance of the instant application is not to be construed as a surrender of subject matter covered by the claims before their cancellation.

Payment Enclosed

The Applicant has enclosed payment for the claims added to the instant application in excess of the amount previously paid for. The payment amount was calculated as shown on the enclosed patent application fee determination record.

² Excerpted from *American Heritage Talking Dictionary*. Copyright © 1997 The Learning Company, Inc. All Rights Reserved.

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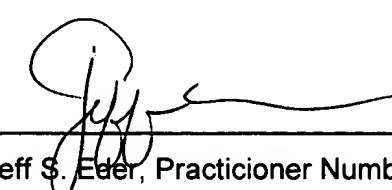
⁴ Excerpted from HyperDictionary.com, Copyright © 2000 – 2003 Webnox Corporation, All Rights Reserved.

Summary

The Applicant respectfully requests consideration of the present application as amended herewith.

Respectfully submitted,

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